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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,255	01/03/2002	Jeffrey N. Eisen	23452-147	9427
29315	7590	10/27/2004	EXAMINER	
MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC 12010 SUNSET HILLS ROAD SUITE 900 RESTON, VA 20190			PAULA, CESAR B	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 10/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/034,255

**Applicant(s)**

EISEN, JEFFREY N.

**Examiner**

CESAR B PAULA

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is responsive to the application filed on 1/3/2002.

**This action is made Non-Final.**

2. Claims 1-22 are pending in the case. Claims 1, 8, and 15 are independent claims.

### *Drawings*

3. The drawings filed on 1/3/2002 have been approved by the examiner.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang (USPub.# 2003/097361, 5/22/2003, filed on 6/15/1999), in view of Barnes, Kate, hereinafter Barnes, "10 Minute Guide to Windows 3.1", Sams, 1992, p. 60-65.

Regarding independent claim 1, Huang discloses a user using checkboxes for selecting files—*documents*-- to be attached to an email from a window display—*summary view*-- (0084, and fig. 7A).

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Moreover, Huang discloses that the user clicks on a button to attach the selected files to the email—*receiving an indication from the user that the user desires to have the computer create a list of the documents selected*. An email window 720 then appears having the selected files —*creating a list of the selected documents and storing them--* (0084, and fig. 7A).

Furthermore, Huang the display of the selected files along with an email recipient's information, icons, and underlining, hyperlinking the file name—*document summary data--* to the file itself—*summary view--* (0084-0085, and fig. 7A-7B). Huang fails to explicitly disclose: *store the list in a system clipboard*. However, Barnes teaches the copying of information using Windows system clipboard (page 60, lines 4-9, 15-19). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Huang, and Barnes, because Barnes teaches above copying data without disturbing the original documents. This provides the benefit of protecting, and preserving the original files attached to the email, so that the user is able to use it without loss or damaging these files.

Regarding claim 2, which depends on claim 1, Huang the display of the selected files along with an email recipient's information, icons, and underlining, hyperlinking the file name—*document summary data--* to the file itself—*summary view--* (0084-0085, and fig. 7A-7B).

Regarding claim 3, which depends on claim 1, Huang the display of the selected files along with an email recipient's information, icons, and underlining, hyperlinking the

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file name—*document summary data--* to the file itself—*summary view--* (0084-0085, and fig. 7A-7B).

Regarding claim 4, which depends on claim 1, Huang the display of the selected files along with an email recipient's information, icons, and underlining, hyperlinking the file name—*document summary data--* to the file itself—*summary view--* (0084-0085, and fig. 7A-7B). Huang fails to explicitly disclose: *documents that are found by an Internet search engine*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have used the search engine to obtain the documents, because Huang teaches that it is often cumbersome to extract items in received email items in a database, and effectively assisting a user in receiving, and manipulating information (0007-0008). This provides the benefit of making it easier for a user to retrieve documents from an Internet database.

Regarding claim 5, which depends on claim 1, Huang the display of the selected files along with an email recipient's information, icons, and underlining, hyperlinking the file name—*document summary data--* to the file itself—*summary view--* (0084-0085, and fig. 7A-7B). Huang fails to explicitly disclose: *documents that are found in a discussion thread*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have used documents in a discussion thread, because Huang teaches effectively assisting a user in receiving, and manipulating information (0008).

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This provides the benefit of making it easier for a user of a bulletin board of manipulating messages being sent, and included in a thread.

Regarding claim 6, which depends on claim 1, Huang discloses the selection of files displayed on the screen checking a checkbox associated with each of the displayed files (0084-0085, and fig. 7A).

Regarding claim 7, which depends on claim 1, Huang the display of the selected files, in a line or row labeled attachment and each of the files in two columns next to each other, along with an email recipient's information, icons, and underlining, hyperlinking the file name—*document summary data*-- to the file itself—*summary view*-- (0084-0085, and fig. 7A-7B). --*table inserting the summary data and the hyperlinks etc.* (0084-0085, and fig. 7A). ). Huang fails to explicitly disclose: *storing the list in a system clipboard*. However, Barnes teaches the copying of information using Windows system clipboard (page 60, lines 4-9, 15-19). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Huang, and Barnes, because Barnes teaches above copying data without disturbing the original documents. This provides the benefit of protecting, and preserving the original files attached to the email, so that the user is able to use it without loss or damaging these files.

Claims 8-14 are directed towards a computer system for implementing the steps found in claims 1-7 respectively, and therefore are similarly rejected.

Claims 15-21 are directed towards a computer readable medium for storing the steps found in claims 1-7 respectively, and therefore are similarly rejected.

Claim 22 is directed towards a computer signal embodied in a computing system for implementing the steps found in claim 1, and therefore is similarly rejected.

### ***Conclusion***

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yost et al. (Pat. # 6,260,050), Flepp et al. (Pat. # 6,684,239), Grauman (Pat. # 6,707,472 ), Pfister et al. (Pat. # 2003/0046365), and Schilit et al. (Pat. # 6,356,922).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-2148. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Any response to this Action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Or faxed to:

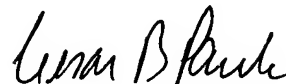
- (703) 703-872-9306, (for all Formal communications intended for entry)

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**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA, Sixth Floor (Receptionist).**



CESAR B PAULA

Patent Examiner

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10/25/04